

commercial on-line service.

Please amend claim 9 as follows:

SURD 2

9.

The terminal of claim 6[, wherein the housing includes] further including a durable enclosure for the CPU, monitor, internal modem and printer[, and a secured access door for service and repair].

REMARKS

I. Protests

Applicant acknowledges the receipt of the three protests filed November 4, 1998, April 1, 1999 and August 17, 1999. With respect to the issues raised by the protests, Applicant acknowledges that the Examiner relied upon some materials and/or arguments in the protests, and rejected others, in issuing the Office Action. Applicant's responses to the Examiner's rejections of claims 1-9 based upon any materials or arguments made in the protests are found in the following sections addressing the Examiner's rejections.

II. Drawings

The Examiner has objected to the drawings on the alleged grounds that the original disclosure does not support the showing of the terminal housing as depicted in Figure 2, which was submitted as part of a substitute sheet of Figure 2 during the prosecution of the original patent. Applicant respectfully disagrees with the Examiner's objection because the substitute drawing of Figure 2 does not constitute new matter.

Figure 2 shows one embodiment of the Applicant's claimed invention. Specifically, Figure 2 shows a housing 10 for the terminal, a monitor 11, a credit card swipe reader 12, keyboard 13, printer paper discharge chute 14, the location 15 of the printer, the location 16 of the CPU with internal modem, and the access door 17. Applicant has amended the specification to remove the references to "printer paper discharge chute" and the "access door" and has submitted a substitute drawing of Figure 2 removing these structures and their corresponding reference numerals. The other structures shown in Figure 2 are found in the disclosure as originally filed on January 23, 1995, and/or one or more of the patents listed at Col. 1, lines 36-56.

A durable enclosure, or housing, for a computer and computer circuits is disclosed in U.S. Patent No. 4,092,527 at Col. 2, lines 66-68; Col. 3, line 3; Col. 3, lines 34-38 and in U.S. Patent No. 5,235,680 at Figures 3 and 4. A monitor for a computer terminal is disclosed at page 5 of the disclosure as originally filed, as well as in U.S. Patent No. 4,274,081 at Figure 1 and Col. 2, lines 27-28. A credit card swipe reader for a computer terminal is disclosed at page 5 of the disclosure as originally filed, as well as in U.S. Patent No. 5,334,823 entitled "Systems and Methods for Operating Data Card Terminals for Transaction Chargeback Protection." A keyboard for a computer terminal is disclosed at page 5 of the disclosure as originally filed, as well as in U.S. Patent No. 4,274,081 at Figure 1 and Col. 2, line 28. A printer for a computer terminal is disclosed at page 5 of the disclosure as originally filed. A CPU with internal modem for a computer terminal is disclosed at page 5 of the disclosure as originally filed. Moreover, all of these structures are reasonably communicated to persons skilled in the art in the disclosure such to enable those skilled in the art to make and use the invention as of January 23, 1995. As discussed in the disclosure as filed, "[i]nterconnection and operability of the components is not discussed in greater detail since

the technology is well known in [the] prior art.” Col. 3, lines 1-3. Therefore, Applicant respectfully submits that Figure 2 does not constitute new matter and respectfully requests that the objection to Figure 2 be withdrawn.

III. Claim Rejections - 35 U.S.C. § 251

A. The Examiner’s Rejections

Claims 6-9 have been rejected under 35 U.S.C. § 251 as being based upon new matter added to the patent for which reissue is sought. The Examiner has stated that the added material which is not supported by the prior patent is “the Internet.”

B. Response To Rejections

Information contained in any one of the specification, claims or drawings of the application as filed may be added to any other part of the application without introducing new matter. As originally filed on January 23, 1995, the disclosure of the application discussed “the Internet” no less than nine times. See pages 2, 4-8 of the original disclosure filed January 23, 1995. The words “the Internet” also remained in that application after several of the uses of the term were erroneously deleted by amendment during the original prosecution. Col. 2, line 12; Col. 2, line 50; Declaration of Richard P. Mettke previously filed with this reissue application. Therefore, ample support exists in the disclosure as originally filed on January 23, 1995 such that the term “the Internet” is not new matter. Accordingly, Applicant respectfully requests that the Examiner’s rejection under 35 U.S.C. § 251 be withdrawn.

IV. Claim Rejections - 35 U.S.C. § 112

A. The Examiner's Rejections

Claims 1-9 have been rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The Examiner states that the terms "housing," "touch screen interface," "touch screen means," "durable enclosure," "secured access door," and the steps of the method claim 5 are not supported by the original disclosure filed on January 23, 1995.

B. Response To Rejections

1. Claims Are Supported by Original Disclosure

Claim 5 has been deleted and claims 1, 2, 6, and 7 have been amended to remove the language objected to by the Examiner. Support for the amendment of claims 2 and 7 is found at Col. 1, lines 43-44.

With respect to claims 4 and 9, the term "durable enclosure" is supported by the disclosure as originally filed on January 23, 1995. As discussed above in connection with the Examiner's objection to Figure 2, a durable enclosure is disclosed in U.S. Patent No. 4,092,527 at Col. 2, lines 66-68; Col. 3, line 3; Col. 3, lines 34-38 and in U.S. Patent No. 5,235,680 at Figures 3 and 4. These patents are specifically identified in the disclosure as originally filed on January 23, 1995. Moreover, a person skilled in the art on January 23, 1995 was fully aware of the use of a durable enclosure in connection with computer terminals. Accordingly, the term "durable enclosure" is not new matter. Therefore, Applicant respectfully requests that the rejections of claims 1-4 and 6-9 under 35 U.S.C. § 112, first paragraph, be withdrawn.

2. Specification Does Not Contain New Matter

With respect to the language added to the disclosure by amendment during prosecution of application 08/376,247 (Col. 2, lines 3-7; Col. 2 line 53 - Col. 3, line 3), Applicant has amended the specification by deleting any reference to the “printer paper discharge chute” and the “access door.” Applicant respectfully submits that the remaining language in Col. 2, lines 3-7 and Col. 2, line 53 - Col. 3, line 3, does not constitute new matter for the reasons discussed above, as well as the reasons discussed in connection with the Examiner’s objection to Figure 2. As discussed above, Applicant submits herewith a substitute drawing page for Figure 2 removing the printer paper discharge chute and the access door. Applicant notes that Figure 2 has been further corrected by changing the reference number “10” to --20-- because Figure 1 already includes the reference numeral 10 for a structure that is different from the structure referred to in Figure 2. Upon the issuance of a Notice of Allowance, Applicant will submit a new formal drawing of Figure 2.

IV. Claim Rejections - 35 U.S.C. § 103(a)

A. The Examiner’s Rejections

Claims 1-4 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over the article entitled “TouchFax Provides the Ultimate in Place-Based Interactivity” (hereafter “Exhibit E” for consistency with the Office Action) in view of the TouchFax brochure entitled “Vision, Power, Versatility” (hereinafter “Exhibit F” for consistency with the Office Action).

Claim 5 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Lockwood et al. in view of the Exhibit E.

Claims 6-9 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Exhibit

E in view of an article by Rawn Shah entitled "Suggestions for Information Kiosk Systems using the World Wide Web" ("Shah Article").

B. Response To Rejections

The PTO has the burden under § 103 to establish a *prima facie* case of obviousness. *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). The PTO can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). If the examiner fails to establish a *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993); *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994) ("If examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.")

A PTO rejection for obviousness is improper when there is nothing in the cited prior art references, either singularly or in combination, to suggest the desirability of the claimed subject matter. *In re Deminski*, 796 F.2d 436 (Fed. Cir. 1986). That the construction in a particular prior art reference would have resulted in the claimed combination had it followed the "common practice" of attaching certain parts does not show obviousness at the time of the invention but rather reflects improper hindsight analysis and the reading into the art of the applicant's own teachings. *Id.* Moreover, combination of one or more references requires a finding on the part of the PTO of a teaching or suggestion, i.e., motivation, to combine the references. *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988); *In re Deminski*, 796 F.2d 436 (Fed. Cir. 1986). Failure to identify any motivation results in a failure to show a *prima facie* case of

obviousness. *In re Rijckaert*, 9 F.3d 1531 (Fed. Cir. 1993); *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994); *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Claims 1-4 and 6-9 are patentable over all of the references cited by the Examiner in the Office Action. None of the references cited by the Examiner discloses, teaches or suggests a pay-as-you-use computer terminal providing access to commercial on-line services or the Internet as claimed by Applicant. Further, the Examiner has failed to identify any motivation to combine Exhibit E with Exhibit F or to combine Exhibit E with the Shah Article. Therefore, the Examiner has failed to establish a *prima facie* case of obviousness of claims 1-4 and 6-9.

With respect to claims 1-4, Applicant submits that Exhibit E is not proper prior art. A reference is proven to be a "printed publication" "upon satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it." *In re Wyer*, 655 F.2d 221, 210 (CCPA 1981); MPEP § 2128. Accordingly, a level of public accessibility is required. MPEP § 2128.01. One example of accessibility is indexing and cataloging printed material. *Id.* A date of publication, i.e., the date the printed matter was first accessible to the public, is also required. MPEP § 2128.02. While the date of publication may be shown through evidence of routine business practices (*Id.*), failure to provide sufficient evidence to prove the date of publication results in the disqualification of the printed matter as prior art.

Exhibit E appears to be an article in the October 1992 journal entitled "Interactive World." The only evidence of this is provided on the face of Exhibit E. Applicant has been unable to determine where to access "Interactive World," or what individuals had access to Exhibit E at any time prior to the filing date of this application, i.e., January 23, 1995. A representative of the

undersigned attorney searched the catalogues of Rice University and the University of Houston, two of the largest library collections in the fourth largest city in the United States and was unable to locate any journal entitled "Interactive World." Results of the searches are attached hereto as Response Exhibit 1. Because no other evidence has been provided by any of the Protestors, or by the Examiner, that Exhibit E was indexed or cataloged such that it was accessible to the public, and Applicant has presented evidence that Exhibit E was not accessible to the public through Rice University or the University of Houston, Applicant submits that Exhibit E is not prior art that can be cited against the claims of this application.

Assuming *arguendo* that Exhibit E is proper prior art, Exhibit E fails to disclose, teach or suggest linking the facsimile kiosk of Exhibit E with commercial on-line service providers. Exhibit E never discusses commercial on-line service providers. Exhibit E is directed to a facsimile kiosk for sending and receiving facsimile transmissions. Exhibit E does suggest that the kiosk may be used to access "information databases," but only in the context of receiving facsimile transmissions from these databases. Exhibit E, page 2, column 2, paragraph 1, lines 3-7. Accordingly, Exhibit E lacks at least the limitation that the terminal include "means for accessing *commercial on-line services*" in claims 1-4. (emphasis added).

Exhibit F is likewise not proper prior art. No evidence has been provided by any of the Protestors or the Examiner as to where Exhibit F can be accessed by the public, or on what date Exhibit F became accessible to the public. Exhibit F may not have been disseminated to anyone outside of Protestor's organization at any time prior to January 23, 1995. Without sufficient evidence to prove (1) whether Exhibit F was ever accessible to the public; and (2) if it was accessible to the public, on what date was it accessible, Exhibit F can not be considered as prior art to the

application.

Assuming, *arguendo*, that Exhibit F is proper prior art, Exhibit F fails to disclose, teach or suggest software installed into the CPU to allow interface with commercial on-line service providers and credit card service centers. Exhibit F simply includes the word "software." Nothing else is discussed about the function(s) this software performs. Furthermore, nothing in Exhibit F discloses, teaches, suggests, or even hints, that the facsimile kiosk is interconnected with commercial on-line services. Accordingly, no person ordinarily skilled in the art would view Exhibit F as teaching to install software into the facsimile kiosk to interface with commercial on-line service providers as recited in claims 1-4. In view of the above remarks and amendments, Applicant respectfully requests that the rejections of claims 1-4 under 35 U.S.C. § 103(a) be withdrawn and claims 1-4 be allowed.

With respect to claim 5, Applicant has deleted that claim. Therefore, the rejection of claim 5 is no longer appropriate.

With respect to claims 6-9, Applicant submits that Exhibit E is not proper prior art for the same reasons discussed above that Exhibit E is not proper prior art with respect to claims 1-4.

Assuming *arguendo* that Exhibit E is proper prior art, Exhibit E fails to disclose, teach or suggest linking the facsimile kiosk disclosed in Exhibit E with the Internet. Exhibit E never discusses the Internet. Exhibit E is directed to a facsimile kiosk for sending and receiving facsimile transmissions. Exhibit E does suggest that the kiosk may be used to access "information databases," but only in the context of receiving facsimile transmissions from these databases. Exhibit E, page 2, column 2, paragraph 1, lines 3-7. Accordingly, Exhibit E lacks at least the limitation that the terminal include "means for accessing *the Internet*" in claims 1-4. (emphasis added).

Like Exhibit E, the Shah Article is also not proper prior art. Neither the Examiner nor the

Protestors has provided any evidence that the Shah Article was accessible to a member of the public exercising reasonable diligence. The Shah Article is only located on the World Wide Web. There is no evidence that the Shah Article is indexed or catalogued in any library or other location accessible to the public. A person skilled in the art would have to know the name of the author, Rawn Shah, to have any chance of locating the article using a search engine on the World Wide Web because the other key terms, e.g., kiosk and Internet, are too generic and would likely result in over 1000 hits. Knowledge of the author of an article, when searching for certain topics, is rarely, if ever, available to the searcher. Therefore, in view of the above remarks, the Shah Article is not prior art properly available to be cited as a basis for rejection claims 6-9 of the application.

Assuming, *arguendo*, that the Shah Article is proper prior art, the Shah Article does not teach the use of any software for interfacing with credit card service centers. There is no discussion anywhere in the Shah Article regarding how a user of the kiosks in the Shah Article would pay for the use of the kiosks. The Examiner erroneously relies upon the statements at page 2, section entitled "Who will use these systems?" and page 5, lines 11-12 for the proposition that the users will pay for access to the Internet through commercial organizations which charge customers for access to specific services. The Shah article never discusses how the user pays for those services. Contrary to the Examiner's citation of pages 3 and 5 of the Shah Article, the commercial organizations' role with the kiosks is as an owner of the kiosk who charges users for the time they use the kiosk. The Shah Article does not discuss the commercial organizations as providing any specific services, let alone charging for Internet access. Further, nothing is disclosed in the Shah Article regarding how these commercial organizations will be paid, let alone, the payment by credit card, at the physical location of the kiosk, utilizing software for interfacing with credit card service centers as recited in

claims 6-9. Accordingly, in view of the above remarks and amendments, Applicant respectfully submits that claims 6-9 are allowable.

Because every element in the independent claims is not disclosed, taught or suggested in the references cited by the Examiner, rejection under 35 U.S.C. § 103(a) is improper. Therefore, Applicants respectfully request that the rejection of claims 1-4 and 6-9 under 35 U.S.C. § 103(a) be withdrawn.

CONCLUSION

In view of the above amendments and remarks, Applicant respectfully requests withdrawal of the rejections and allowance of claims 1-4 and 6-9.

Date: 11/22/99

Respectfully submitted,



Edward W. Goldstein

Reg. No. 22,945

TOBOR, GOLDSTEIN & HEALEY, L.L.P.

1360 Post Oak Blvd., Suite 2300

Houston, Texas 77056-3023

Tel: (713) 877-1515

Fax: (713) 877-1145

Attorneys for Applicant

F:\CLIENT\6\6388\005\PTO\ROA1.AFM